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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/688,995 | 10/21/2003 | Ron Darziv | 2808/20 | 4546 |

7590 08/24/2007
DR. MARK FRIEDMAN LTD.
c/o Bill Polkinghorn
Discovery Dispatch
9003 Florin Way
Upper Marlboro, MD 20772

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| EXAMINER |
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MORAN, RANDAL D

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| ART UNIT | PAPER NUMBER |
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2135

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| MAIL DATE | DELIVERY MODE |
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08/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/688,995

Applicant(s)

DARZIV ET AL.

Examiner

Randal D. Moran

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8, 10, 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10, 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Office Action is in response to an amendment filed 6/7/2007.
2. Claims 2, 9, 11, and 18 have been canceled. Claims 1, 3-8, 10, and 12-17 are pending in the application.
3. Below, Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully each reference in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 3-8, 10, and 12-17** are rejected under 35 U.S.C. 102(b) as being anticipated by **Christiano (US 5,386,369)**.
3. Considering **Claim 1**, Christiano discloses a method for hiding information on a computer (column 1- lines 53-59), the method comprising: a) retrieving an identity of a computer component (column 3- lines 41-47); b) deriving a name from said identity in a secret manner (column 4- lines 6-20), c) storing the information on the computer in a storage entry identified by said name (Fig. 9A and B, column 9- lines 53-68, column 10- lines 1-8).
4. Considering **Claim 10**, Christiano discloses a method for securely storing information on a computer and retrieving said information (column 1- lines 53-59), said method comprising the steps of: storing said information by: a) retrieving an identity of at least one computer component (column 3- lines 41-47); b) deriving at least one identifier from said identity of said at least one computer component (column 4- lines 6-20), c) for each of said at least one identifier, storing said information on said computer in a storage entry corresponding to said identifier (Fig. 9A and B, column 9- lines 53-68, column 10- lines 1-8); d) retrieving the identity of said at least one computer component (column 3- lines 41-47); e) deriving in the manner of step (b) said at least one identifier from said

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identity of at least one computer component (column 4- lines 6-20) f) for each of said at least one identifier, retrieving the stored information by: retrieving said information on said computer from a storage entry corresponding to said identifier (Fig. 9A and B, column 9- lines 53-68, column 10- lines 1-8).

5. Considering **Claims 3 and 12**, Christiano discloses the information is encrypted prior to said storing (column 3- lines 47-51).
6. Considering **Claims 4 and 13**, Christiano discloses storage entry is selected from the group consisting of: a file, a registry entry, and a database entry (column 9- lines 63-68, column 10- lines 1-8)
7. Considering **Claims 5 and 14**, Christiano discloses identity is selected from the group consisting of: a serial number, a model type, a component type, a volume name, a physical location, and a network address (column 3, lines 67-68, column 4- lines 1-2).
8. Considering **Claims 6 and 15**, Christiano discloses at least one computer component is selected from the group consisting of: a hard drive, a network card, a CPU, a computer chip, a computer program, a BIOS, and a file (column 3- lines 45-51).

9. Considering **Claims 7 and 16**, Christiano discloses deriving a name (column 4- lines 9-20) further comprises: a) generating a pseudo-random sequence whose seed is based on a numeric value derived from said identity (column 4- lines 9-20); and b) deriving said name from at least one member of said pseudo-random sequence (column 4- lines 9-20).
10. Considering **Claims 8 and 17**, Christiano discloses computer component is remotely accessible by said computer (column 1- lines 53-59).

Response to Arguments

1. Applicant's arguments filed 6/7/2007 have been fully considered but they are not persuasive.
2. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the storage of information in a manner making full use of the operational data

storage capabilities featured on a computer, hiding information to deter an attacker) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. In response to applicant's argument that Christiano fails to disclose the goal of hiding information to deter an attacker, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

5. Regarding **Claims 1, 3-8, 10, and 12-17**, applicants arguments have been fully considered but they are not persuasive. With respect to applicants argument that Christiano fails to teach the storage of information in locations having names derived in a secret manner. Examiner disagrees and directs the applicant to Christiano – column 4- lines 6-20, Figures 9A and B, column 9- lines 53-68, column 10- lines 1-8. Christiano discloses the storage of information into slots corresponding to the unique identifier derived from the identity of the transaction (i.e. deriving a name and storing the information into memory based on said name). Deriving the name in a secret manner is disclosed in that the formula used to create the “name” should be one that is non-obvious to users.

Conclusion

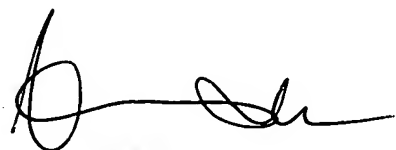
1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randal D. Moran whose telephone number is 571-270-1255. The examiner can normally be reached on M-F: 7:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randal D. Moran
/RDM/

8/20/2007



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100